In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 617

LYLE B. BOBST, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The opinion of the Patent Office Board of Appeals (App. 11a–16a) [1] is unreported. The opinion of the United States Court of Customs and Patent Appeals is reported at 345 F. 2d 851.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on May 27, 1965 and a timely petition for rehearing was denied on July 1, 1965. The petition for a writ of certiorari was filed on September 27, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

[1] "App." references are to the appendix to the petition.

705-455—65

QUESTION PRESENTED

Whether a disclosure contained in a publication need actually have been reduced to practice in order to constitute a relevant prior art reference within the Patent Act.

STATUTES INVOLVED

35 U.S.C. 102 provides, in relevant part:

> *Conditions for patentability; novelty and loss of right to patent.*
>
> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> * * * * *

35 U.S.C. 103 provides, in pertinent part:

> *Conditions for patentability; non-obvious subject matter*
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

42 U.S.C. 2185 provides:

> *Prior art*
>
> In connection with applications for patents covered by this subchapter, the fact that the invention or discovery was known or used before shall be a bar to the patenting of such invention or discovery even though such prior

knowledge or use was under secrecy within the atomic energy program of the United States.

STATEMENT

On April 24, 1957, petitioner applied for a patent on a "neutron amplifier," a device designed for the safe production of neutrons. Relying upon a 1947 article written by one Samsel, the Examiner rejected claims 27 through 33 of petitioner's application, and that decision was affirmed by the Board of Patent Appeals.[2] Claims 27 and 30–32 were rejected as fully disclosed by the Samsel article; claims 28, 29 and 33 were rejected as obvious in view of Samsel (see 35 U.S.C. 103, *supra*, p. 2).[3]

In the Court of Customs and Patent Appeals, petitioner contended that Samsel could not be consulted as a reference because the publication indicated that Samsel had not tested out the ideas which were there formulated. The Court of Customs and Patent Appeals, however, agreeing with the Patent Office, held that reduction to practice is not essential for this purpose (App. 8a):

> The mere fact that a disclosure is contained in a patent or application and thus "construc-

[2] Petitioner's application contained 34 claims. Claims 1–15 and 17–26 were cancelled and claims 16 and 34 were allowed (App. 18a, 19a).

[3] For ten years following its publication, the Samsel article remained a classified document of the Atomic Energy Commission. It was made public on March 19, 1957, prior to the filing date of petitioner's application. Even if it had not been declassified, however, the fact of its secrecy would not alone have been sufficient to preclude its use as a prior art reference. See 42 U.S.C. 2185, *supra*, pp. 2–3.

> tively" reduced to practice, or that it is found in a printed publication, does not make the disclosure itself any more meaningful to those skilled in the art (and thus, ultimately, to the public). Rather, the criterion should be whether the disclosure is *sufficient to enable one skilled in the art to reduce the disclosed invention to practice*. In other words, the disclosure must be such as will give possession of the invention to the person of ordinary skill. Even the act of publication or the fiction of constructive reduction to practice will not suffice if the disclosure does not meet this standard.

Applying this standard the court found, as had the Patent Office, that the Samsel publication was sufficiently complete to enable one skilled in the art to practice the invention which it disclosed. Since Samsel fully anticipated claims 27 and 30–32 of petitioner's application, rejection of those claims was affirmed. The court found, however, that claims 28, 29 and 33 were neither anticipated nor rendered obvious by Samsel and reversed the rejection of those claims.

ARGUMENT

The Court of Customs and Patent Appeals correctly found Samsel to be a relevant reference under the Patent Act although the invention disclosed in the Samsel publication was not reduced to practice. While dicta in some cases decided considerably before the Patent Act of 1952 appear to support petitioner's view, no present conflict exists with decisions of this

Court or of any lower federal court. Accordingly, there is no occasion for further review.[4]

Section 102(a) of the Patent Act (35 U.S.C. 102(a)) provides that a patent may not be obtained on an invention which "was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant * * *." Section 103 of the Act (35 U.S.C. 103) provides, in addition, that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *." The Atomic Energy Act adds that these prior art bars shall apply "even though such prior knowledge or use was under secrecy within the atomic energy program of the United States." 42 U.S.C. 2185.

Petitioner does not take issue with the finding that Samsel, if available as a reference, in fact anticipates claims 27 and 30–32 of his application; he recognizes further that the "secrecy" of Samsel alone does not preclude its use as an anticipatory reference under the Atomic Energy Act. Petitioner argues instead that the Samsel publication is not relevant since the

[4] There is currently pending before this Court the issue whether certiorari jurisdiction exists under 28 U.S.C. 1256 to review decisions of the Court of Customs and Patent Appeals in patent cases. *Brenner* v. *Manson*, No. 58, October Term, 1965. We urge in that case that such jurisdiction does exist where the criteria for this Court's review are otherwise satisfied.

author did not test out the disclosures there made by the construction of a working reactor.

However, actual reduction to practice, although a condition precedent to patentability, is not necessary to qualify a reference as relevant prior art. All that is necessary is that the disclosure be sufficiently complete to enable persons skilled in the art to which it relates to reduce it to practice. *Downton* v. *Yeager Milling Co.*, 108 U.S. 466, 477; *Cohn* v. *United States Corset Co.*, 93 U.S. 366, 370; *Seymour* v. *Osborne*, 11 Wall. 516, 555. While statements lending some support to petitioner's view exist in the two decisions of this Court upon which he principally relies (*Gayler* v. *Wilder*, 10 How. 476, 497; *Coffin* v. *Ogden*, 18 Wall. 120, 124), in *Coffin* the patent in issue was held invalid on the basis of the prior art, and *Gayler* concerned the rule regarding an abandoned invention. In all events, the subsequent statements of this Court in *Downton* v. *Yeager Milling Co., supra,* and *Cohn* v. *United States Corset Co., supra,* support the rule, adopted here by the Court of Customs and Patent Appeals, *i.e.*, that actual reduction to practice is not necessary to qualify a reference as relevant prior art.

Petitioner also relies upon *Block* v. *Nathan Anklet Support Co.*, 9 F. 2d 311, 313 (C.A. 2), decided in 1925. While Judge Learned Hand suggested in that case that for a reference to qualify as a prior art "nothing short of 'reduction to practice' will do, whatever that may mean," the statement is clearly dictum, for the prior art in *Block* had in fact been embodied

in a hand-made model, and the court was therefore "relieved in the case at bar from deciding whether the earlier invention must always take tangible embodiment and be ready for immediate use." *Ibid.* Finally, in *Stearns* v. *Tinker & Rasor,* 220 F. 2d 49 (C.A. 9) the court properly refused to permit an unrecorded "belief" to anticipate where that belief was not disclosed until after the date of fruition of the challenged invention.[5]

Thus, the court below properly held that the critical inquiry is "whether the disclosure is *sufficient to enable one skilled in the art to reduce the invention to practice*" (App. 8a). It seems evident that if the prior disclosure is so complete as to enable persons skilled in the art to practice it, nothing patentable is added by the fact that the inventor has merely followed its teaching.

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[5] The present decision of the Court of Customs and Patent Appeals is, however, in apparent conflict with the prior decision in *Application of Schlittler*, 234 F. 2d 882, 886, which the court overruled in this case (App. 8a).

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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REPLY BRIEF FOR PETITIONER

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

REPLY BRIEF TO BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

Contrary to the Brief in Opposition, the Petition is not concerned with a disclosure contained in a publication. Rather, petitioner seeks review of a finding, upheld by the court below, that the invention had been "known" before. The prior knowledge was an idea contained in a technical report.

There had been no publication of Samsel's technical suggestions. The Samsel paper was classified secret by the Atomic Energy Commission throughout the period of its alleged pertinence as evidence of prior knowledge. Its